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OFFICE OF PETITIONS

LAW FIRM OF ANDREA HENCE EVANS
14625 BALTIMORE AVENUE, #853
LAUREL, MD 20707

In re Patent of Mia Minnelli :
Patent No. 6,263,884 :
Issue Date: July 24, 2001 : Decision on Petition
Application No. 09/525,601 :
Filing Date: March 14, 2000 :
Attorney Docket No. Mia Minnelli¹ :

This is a decision on the petition under 37 C.F.R. § 1.378(b) filed February 2, 2012, to reinstate the above-identified patent.

The petition is **DISMISSED**.

As a preliminary matter, the Office notes the identity of the owner of the patent is unclear. The petition implies the inventor owns the patent. However, an assignment of all rights in the application from the inventor to The Tonytail Company, Inc. ("Tonytail") was recorded with the Office during 2007. If a request for reconsideration is filed, the request should clearly identify the owner of the patent.

The showing provided in support of the petition consists of the following assertions:

1. The inventor entered the due date for the maintenance fee into a database;
2. The inventor marked the due date on a calendar;
3. The inventor had surgery as the result of an unidentified illness;
4. The inventor's surgery took place during 2009 during the time period the maintenance fee could have been paid;
5. The inventor is still recovering from the illness and is still being treated for the illness;
6. The inventor engaged The Law Firm of Andrea Hence Evans, LLC ("Firm") to handle patent prosecution involving unidentified matters;
7. On January 23, 2012, the Firm notified the inventor the patent had expired.

¹ The identified docket number is the docket number identified on the power of attorney filed with the petition. The attorney docket number identified on the petition is "Mia Kaminski."

Analysis

A grantable petition under 37 C.F.R. § 1.378(b) must be accompanied by a showing to the satisfaction of the Director that the entire delay in paying the required maintenance fee from the due date for the fee until the filing of a grantable petition pursuant to this paragraph was unavoidable.

In order for a party to show unavoidable delay, the party must show "reasonable care was taken to ensure that the maintenance fee would be promptly paid."² The level of "reasonable care" required to be shown is the same as the level of "care or diligence ... generally used and observed by prudent and careful men in relation to their most important business."³ When determining if a period of delay has been shown to have been unavoidable, the Office will take "all the facts and circumstances into account" and will decide each petition "on a case-by-case basis."⁴

The 7.5 year maintenance fee could have been paid from July 24, 2008, to January 26, 2009, or with a surcharge from January 27, 2009, to July 24, 2009. The fee was not timely paid and the patent expired July 25, 2009.

The petition appears to suggest Ms. Minnelli's surgery and/or illness prevented Ms. Minnelli from timely paying the 7.5 year maintenance fee. However, the petition fails to identify the illness, the nature of the illness, the severity of the illness, the nature of the surgery, or the date of the surgery. In other words, the petition fails to explain how the surgery and/or illness prevented Ms. Minnelli from reviewing either the cited database or her calendar, recognizing the maintenance fee was due, and submitting the maintenance fee to the Office.

The petition fails to discuss the number of individuals employed by Tonytail during 2009, or discuss the extent to which Ms. Minnelli could have shifted the burden of timely paying the maintenance fee to another employee once she became unable to handle such a burden due to her health.

Even if the record demonstrated Ms. Minnelli's failure to pay the maintenance fee on or before July 24, 2009 was unavoidable, the petition could not be granted because the petition fails to establish the *entire* delay in the submission of the fee was unavoidable. Specifically, the petition fails to demonstrate Ms. Minnelli was unable from July 25, 2009, through the end of 2011, to personally review, or have another employee review, the database or her calendar to determine if any due dates for any matters had been missed as a result of her surgery and/or illness.

² 37 C.F.R. § 1.378(b).

³ *In re Mattulath*, 38 App. D.C. 497, 514-15 (D.C. Cir. 1912). *See also Ray v. Lehman*, 55 F.3d 606, 34 U.S.P.Q.2d (BNA) 1786 (Fed. Cir. 1995) (citations omitted) ("[I]n determining whether a delay in paying a maintenance fee was unavoidable, one looks to whether the party responsible for payment of the maintenance fee exercised the due care of a reasonably prudent person.")

⁴ *Smith v. Mossinghoff*, 671 F.2d 533, 538, 213 U.S.P.Q. (BNA) 977 (D.C. Cir. 1982).

The 3.5 year maintenance fee was timely paid in Patent No. 7,017,589, which has the same inventor and the same assignee. The record fails to include any explanation of how the inventor's health could have prevented the timely payment of the maintenance fee for the instant patent, but not for Patent No. 7,017,589.

In view of the prior discussion, the record is insufficient to demonstrate the entire delay in the submission of the 7.5 year maintenance fee was unavoidable.

Petitioner's Current Options

I. Petitioner May File a Request for Reconsideration.

Petitioner may file a request for reconsideration in response to the instant decision. Any request for reconsideration must be submitted within TWO (2) MONTHS from the mail date of this decision and include a non-refundable petition fee of \$400. Extensions of time under 37 C.F.R. § 1.136(a) are NOT permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 C.F.R. § 1.378(b)."

If a request for reconsideration is filed, the request should identify and discuss the nature and degree of the health problems that petitioner asserts prevented petitioner from timely paying the maintenance fee or from filing a petition to reinstate the patent on an earlier date.

If a request for reconsideration is filed, the request should include a statement from Ms. Minnelli's treating physician addressing the nature and severity of Ms. Minnelli's health problems during the entire time period from June 2009 through December 2011.

If a request for reconsideration is filed, the request should identify and *fully* discuss the *exact* extent to which Ms. Minnelli's health problems limited her ability to be employed, or to perform job duties, during the entire relevant time period.

If a request for reconsideration is filed, the request should identify each month from June 2009 to December 2011, during which Ms. Minnelli consulted the database or calendar on at least one occasion concerning any matter.

If a request for reconsideration is filed, the request should fully explain how the inventor's health prevented petitioner from timely paying the maintenance fee for the instant patent, but not for Patent No. 7,017,589.

If a request for reconsideration is filed, the request should address the impact Ms. Minnelli's ability had on petitioner's ability to pursue various matters before the Office by identifying all discussing *all* papers and fees filed with the USPTO, including papers and fees related to trademarks, from June 2009 through December 2011, by Ms. Minnelli, by an individual on behalf of Ms. Minnelli, by Tonytail, or by an individual on behalf of Tonytail.

After a decision on the petition for reconsideration is issued, no further reconsideration or review of the matter will be undertaken by the Director. Therefore, petitioner should supply any

and all additional relevant information and documentation which support petitioner's assertion the delay in payment of the maintenance fee was unavoidable.

II. Petitioner May Request a Refund of Fees Filed With the Instant Petition.

Since the petition is dismissed, petitioner may request a refund of the maintenance fee and surcharge. Petitioner is reminded that if a request for reconsideration is later filed along with the \$400 fee, the \$400 will not be refunded. A request for a refund should be sent to: Mail Stop 16, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450. A copy of this decision should accompany any request for refund.

Further correspondence with respect to this matter may be submitted as follows:

By Internet: A request for reconsideration may be filed electronically using EFS Web.⁵ Document Code "PET.OP" should be used if the request is filed electronically.

By mail: Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

By facsimile: (571) 273-8300
Attn: Office of Petitions

By hand: U.S. Patent and Trademark Office
Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Telephone inquiries regarding this communication should be directed to Petitions Attorney Steven Brantley at (571) 272-3203.



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⁵ General Information concerning EFS Web can be found at <http://www.uspto.gov/patents/process/file/efs/index.jsp>.